



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
---------------	-------------	----------------------	---------------------

Serial No. 8307,621 Filing Date 11/14/94 Inventor DOLYNCHUK 2- K 1887-111-MIS
Art Unit 1803 EXAMINER GRIFFIN,R

The Group and/or Art Unit location of your application PAPER NUMBER
SIM AND MCBURNEY
330 UNIVERSITY AVENUE
SUITE 701
TORONTO ONTARIO CANADA M5G 1R7
application, all further correspondence regarding this
application should be directed to Group Art Unit 1803.
DATE MAILED: 10/16/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been filed with informal drawings under

This application has been examined Responsive to communication filed on 7/20/94 This action is made final.

Note the objections to the drawing THREE 37 CFR 1.84 set forth.
A shortened statutory period for response to this action is set to expire month(s), days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133
on the form PTO-948 enclosed herewith.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6. Set forth in this Office

Part II SUMMARY OF ACTION

1. Claims 8-15 are pending in the application.
A patent may not be obtained though the invention is not
~~of the above claims disclosed or described as set forth in the application~~ withdrawn from consideration.
of this title, if the differences between the subject matter
2. Claims ~~ought to be patented and the prior art are such have been cancelled.~~
subject matter as a whole would have been obvious at the time
3. Claims ~~the invention was made to a person having ordinary skill in the art~~ are allowed in
the art ~~in which said subject matter pertains.~~ Patentability
4. Claims ~~shall not be negatived by the manner in which the application~~
~~was made.~~
5. Claims ~~are objected to.~~
6. Claims ~~subject matter developed by another person, which qualifies as~~
~~subject matter only under subsection (f) or (g) of section 102 of~~
7. This application has been filed with informal drawings under 37 CFR 1.85 which are acceptable for examination purposes.
this title shall not preclude patentability under this
8. Formal drawings are required in response to this Office action.
were, at the time the invention was made, owned by the same
9. The corrected or substitute drawings have been received in ~~in connection of assignment~~ Under 37 CFR 1.84 these drawings
are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. The proposed additional or substitute sheet(s) of drawings, filed on ~~10/16/95~~, has (have) been approved by the
examiner; disapproved by the examiner (see explanation).
In this application currently named inventors. In
11. The proposed drawing correction, filed ~~10/16/95~~, has been approved; disapproved (see explanation).
considering patentability of the claims under 35 U.S.C. § 103,
12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received
the ~~been filed in parent application, serial no. 10/16/95~~ the subject matter of the various claims
13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in
accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. Other

SN08/307621

EXAMINER'S ACTION

Serial No. 08/307,621
Art Unit 1803

-2-

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1803.

This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes. Note the objections to the drawings under 37 CFR 1.84 set forth on the form PTO-948 enclosed herewith.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims

was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 8-15 are rejected under 35 U.S.C. § 103 as being unpatentable over Moorhead (4,444,787), Chvapil (4,485,088), and Raisfeld (4,507,321), taken in view of University of Texas (WO 91/10427). Treatment of scar tissue with compounds within the scope of those set forth in the instant claims is shown by Moorhead (note aminoacetonitrile at column 2, lines 9-25 and column 5, lines 1-30; and scaring at column 3, lines 24-64), Chvapil (note aminoacetonitrile at ABSTRACT; scar contractures and fibrotic structures at column 1, lines 20-52), and Raisfeld (note wound healing, treating burns at ABSTRACT; spermidine at column 2, line 68 & column 6, line 43; putrescine at column 3, line 2 and column 5, line 53). Selection of other transglutaminase inhibitors and determination of suitable effective amounts thereof such as the amounts set forth in instant claims 9 and 10 would have been obvious at the time the invention was made to a person having ordinary skill in this art as exemplified by University of Texas which discloses the effect of transglutaminase inhibition in treating filariasis (page 5,

Serial No. 08/307,621
Art Unit 1803

-4-

lines 4-20) and as such is of no patentable moment in the absence of any showing of unexpected and/or unobvious results obtained thereby.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed. 2nd 545 (1966), 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103 are summarized as follows:

1. Determining the scope and contents of the prior art;
2. Ascertaining the differences between the prior art and the claims at issue; and
3. Resolving the level of ordinary skill in the pertinent art.

The other documents, set forth on the enclosed form PTO-892, have been considered by the examiner. Such are of interest as further showing the state of the art.

Summary: rejected, claims 8-14; stand cancelled, claims 1-7.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE **THREE MONTHS** FROM THE DATE OF THIS LETTER. FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED. NOTE 35 U.S.C. 133.

Any inquiry concerning this communication should be directed to Ronald W. Griffin at telephone number (703) 308-4619
R.W.Griffin
October 6, 1995

Ronald W. Griffin
RONALD W. GRIFFIN
PRIMARY EXAMINER
ART UNIT 1803